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Applicant(s): Gregory Winfield Gorman

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TAPE

October 22, 2007

**Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

REPLY BRIEF

Dear Sir:

In accord with 37 C.F.R. §§ 41.37(c) and 41.41(a), Appellant hereby files a reply brief in response to the Examiner's Answer mailed August 22, 2007 and in further support of the Appeal in the above-identified matter (hereinafter, the “943 Application”). An appeal brief was filed May 2, 2007, responsive to the non-final office action of December 04, 2006, the previous final office action of May 17, 2006 and the advisory action of August 3, 2006. A notice of appeal was submitted on March 2, 2007.

Pursuant MPEP 1208(I), and in compliance with 37 C.F.R. §41.37(c), this reply brief includes the following items, each starting on a separate page:

- I.** This Identification Page;
- II.** Status of Claims, on page 2;
- III.** Grounds of Rejection to be Reviewed on Appeal, beginning on page 3;
and
- IV.** Arguments, beginning on page 4.

II. Status of Claims.

Claims 1-11 and 28-34 are pending in this application, with claims 1, 9, 10 and 28 being independent. Claims 20-27 were cancelled in a response to restriction requirement, filed and entered February 18, 2005. Claims 12-19 and 35 were cancelled in a rule 116 amendment on July 17, 2006. Appellant is unsure of the status of these claims, due to contradictory information from the Examiner. The Examiner now indicates "regarding the amendment filed 7/17/2006 (after final amendment)...said amendment was denied entry and the amendment was not re-entered. The status of said amendment has not changed." Examiner's Answer of August 22, 2007, page 2, item 4. Furthermore, the Examiner's Answer now lists claims 12-19 and 35 among the rejected claims. However, the Examiner previously treated claims 12-19 and 35 as if they had in fact been cancelled, by (a) failing to list claims 12-19 and 35 as "pending" in the Office Action Summary mailed December 4, 2006, and (b) failing to address claims 12-19 and 35 in the rejections presented in the December 4, 2006 Office Action.

Pursuant the Examiner's Answer of August 22, 2007, claims 1-8, 11 and 28-34 stand rejected under 35 U.S.C. § 112 as failing to comply with the written description requirement. Claims 1-5, 7-8, 11, 28-32 and 34 also stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,514,655 ("Bastiaens"). Claims 6 and 33 also stand rejected under U.S.C. § 103(a) as being unpatentable over Bastiaens. Claim 9 stands rejected as being anticipated by U.S. Patent No. 6,576,074 ("Cabrera"). Claim 10 stands rejected as being anticipated by U.S. Patent Application Publication No. 2003/0123930 A1 ("Jacobs"). We appeal all claims 1-11 and 28-34.

III. Grounds for rejection to be reviewed on appeal.

- (A)** Whether claims 1-8, 11 and 28-34 are unpatentable under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.
- (B)** Whether claims 1-5, 7-8, 11-14, 16-17, 19, 28-32 and 34 are unpatentable over 35 U.S.C. § 102(e) in view of Bastiaens.
- (C)** Whether claims 6 and 33 are unpatentable over U.S.C. § 103(a), due to Bastiaens.
- (D)** Whether claim 9 is unpatentable over 35 U.S.C. § 102(e) in view of Cabrera.
- (E)** Whether claim 10 is unpatentable over 35 U.S.C. § 102(e) in view of Jacobs.
- (F)** Whether this case should be remanded to the Examiner for entry of the amendment filed July 17, 2006.

IV. Argument.

In order to facilitate consideration of Appellant's claims against the Bastiaens patent, we first provide a general discussion and comparison of Bastiaens versus the '943 Application and claims. We then address and argue the rejection of claims 1-8 and 11. Claims 12-19 were cancelled July 17, 2006, and the Examiner appeared to accept these cancellations, since he did not list the claims as pending in the Office Action of December 4, 2006. The Examiner now (contradictorily) appears to take the position that these claims were not properly cancelled due to non-entry of Appellant's July 17, 2006. If this is so, Appellant submits that this case should be remanded to the Examiner for issuance of a new non-final Office Action that properly indicates non-entry of the claim cancellation. See Argument (F), below. However, in any case, claims 12-19 are not appealed and so are not argued herein.

General Discussion.

Before addressing the specific patentable elements of the aforementioned claims, we note that prior office actions suggest a fundamental confusion as to the invention and process of the Bastiaens patent. We therefore provide the following discussion in an attempt to clarify.

Bastiaens recites an electrographic process for making a base construction that is useful in making retroreflective graphic articles. In this process, an image is electrographically printed on a transfer sheet. The imaged transfer sheet is then pressed against a receptor sheet, at an elevated temperature, to transfer the image to the surface of the receptor sheet. The receptor sheet includes glass microspheres enclosed within a binder layer. A specular reflective layer, such as a "vapor deposited aluminum film" underlies the binder layer. Bastiaens col. 4, lines 13-14. An adhesive layer is shown underlying the specular reflective layer, and an optional removable release liner is shown underlying the adhesive. See Bastiaens col. 2, line 63 – col. 3, line 6; FIG. 2.

Following image transfer, the image transfer sheet is collected by a pickup roll. The imaged receptor sheet is collected on a separate pickup roll. At this point, the

receptor sheet is described as “suitable for making retroreflective articles.” See Bastiaens col. 2, line 63 – col. 3, line 22; FIGs. 2 and 3.

In order to make the retroreflective article from the receptor sheet, a transparent cover film is applied over the image, by contacting the cover film with the imaged receptor sheet, and passing the two through pressure rolls, “to provide an imaged retroreflective article.” See Bastiaens col. 3, lines 23-32; FIG. 4. Preferably, a clear film is next applied (e.g., by lamination or as a topcoat) over the image. See Bastiaens col. 4, lines 53-54; col. 4, line 66 - col. 5, line 15.

Argument (A).

Claims 1-8, 11 and 28-34 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. We respectfully disagree. These claims do not stand or fall together.

(1) Arguments Responsive to the Examiner's Answer of August 22, 2007

Appellant maintains the arguments presented in the Appeal Brief of May 2, 2007. These arguments are reiterated below. However, Appellant additionally notes that the Examiner's Answer of August 22, 2007 argues: “The phrase ‘homogeneous composition’ in claim 1 and 28 is not supported by the specification, as originally filed, *because figures 5-13 merely describes the homogeneous structure* and contains no description as to the identity or nature of the composition.” Examiner's Answer p. 4, first paragraph. The Examiner admits that Appellant's figures disclose a homogeneous structure. However, the Examiner previously rejected and did not enter the following amendment:

“FIG. 1 depicts a top view of a section of a continuous pavement tape 100. This tape comprises a homogeneous tape body 101 and a series of symbols 102 arrayed on the surface of the tape body. Here the symbols 102 define the first three letters of the English alphabet.” *Amendment and Response filed July 17, 2006.*

Respectfully, the Examiner's admission of homogeneity (see above quote) directly contradicts his prior refusal to enter the above amendment. And the above amendment, if

entered, would provide clear support for the homogeneous tape body of claims 1 and 28. Appellant submits that for at least this reason, this case should be remanded to the Examiner for preparation of a new, non-final Office Action indicating entry of the July 17 amendment to the Specification. See also Argument (F), below.

Also given the Examiner's admission, it appears that the term "homogeneous" itself is no longer at issue, but rather, the precision of language used to present the term. Respectfully, this is no longer a § 112 issue. Pursuant MPEP § 2173.02, "if the language used by applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph, but the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. 112, second paragraph, rather, the examiner should suggest improved language to the applicant." The Examiner appears to be suggesting improved language by discussing composition *vs.* structure; however, this suggestion is not given in a manner (or in a time) where Appellant cannot apply the Examiner's suggestion! While the Examiner's clarification and suggestion is appreciated, the '943 Application is not currently at a stage of prosecution where Appellant can address the semantics issues that the Examiner now brings forth. Remanding this case to the Examiner would allow Appellant to properly reply, now that the Examiner's position is known.

Finally, Appellant maintains that the limitation of homogeneous composition is inherently disclosed in the specification. See reiterated arguments, below.

(2) Appeal Brief Arguments - Reiterated

Claim 1: In particular, in the final office action of May 15, 2006, the Examiner stated that the phrase "homogeneous composition" in claim 1 (and also claim 28, argued below) was not supported by the '943 Application, as originally filed, because of lack of any definition therefor in the specification. The Examiner also stated that the meaning of this phrase was unclear.

In response, we clarified that a homogeneous material is uniform in structure or composition throughout. *The American Heritage® Dictionary of the English Language*,

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Fourth Edition, Copyright © 2000 by Houghton Mifflin Company. “Consistent” and “uniform” are exemplary synonyms of “homogeneous”.

Regarding the Examiner’s assertion of lack of support for the term “homogeneous composition,” we noted that “While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, *or inherent* disclosure.” MPEP § 2163(I)(B), emphasis added. We argued, and we maintain, that the limitation of homogeneous composition is inherently disclosed in the specification, at least because the specification references the drawings, which show a homogenous (e.g., consistent or uniform) tape body. See, e.g., tape body 101, Figs. 5-13.

Per MPEP § 2163.06, “...information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter.” The amendment to claim 1 constitutes the addition of pictorial information from the drawings into the claim, and is therefore acceptable and in compliance with 35 U.S.C. §112, first paragraph.

Furthermore, we submit that this pictorial information (e.g., of FIGs. 5-13) supports Appellant’s possession of a homogenous tape body. Regarding possession, in describing the guidelines for the examination of patent applications under the 35 U.S.C. § 112, paragraph 1, “Written Description” Requirement, it is clearly stated that:

“An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, *figures, diagrams*, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).” MPEP § 2163(I), emphasis added.

For at least these reasons, we believe that claim 1 complies with the requirements of 35 U.S.C. § 112. Withdrawal of the Examiner’s rejection is therefore respectfully requested.

As an aside, we note that the Examiner rejects claim 1 as not finding specific support in the specification. However, in order to maintain consistency between the claims, drawings and specification, and because MPEP § 2163.06 permits, we did present an amendment to the specification in our July 17, 2006 response. This amendment

referenced a “homogeneous” tape body. We submit that the amendment to the specification should have been entered because, contrary to the Examiner’s assertion, it did not add new matter (see above argument directed to importing drawing features into “any other part” of an application; see also FIGs. 5-13). We therefore also request entry of the amendment to the specification filed July 17, 2006.

Claim 2: Claim 2 depends from claim 1 and benefits from like argument. In addition, claim 2 is original. The claims are considered a part of the application, thus, the recited rear face with adhesive for bonding pavement tape to pavement is also supported by the ‘943 Application as filed. See also supporting FIGs. 2, 5-13 and Specification p. 3, ¶[0011]. We respectfully request withdrawal of the Examiner’s rejection.

Claim 3: Claim 3 depends from claim 1 through intervening claim 2, and therefore benefits from like argument. Claim 3 is also original, and therefore supported by the ‘943 Application as filed. See also FIGs. 12, 13 depicting the recited flexible release tape. Claim 2 therefore complies with 35 U.S.C. §112, first paragraph. Accordingly, we respectfully request withdrawal of the Examiner’s rejection.

Claim 4: Claim 4 depends from claim 1, and therefore benefits from like argument. Claim 4 is also original, and therefore supported by the ‘943 Application as filed. See also FIGs. 6-13 depicting the recited flexible protective tape. Claim 3 therefore complies with 35 U.S.C. §112, first paragraph. Withdrawal of the Examiner’s rejection is respectfully requested.

Claim 5: Claim 5 is likewise original and therefore supported by the ‘943 Application as filed. See description of symbols conveying commercial information at Specification p. 3, ¶[0011]; p. 11 ¶[0072]-[0074]; see also FIGs. 13B and 13C. Claim 5 also depends from claim 1 through intervening claim 2, and benefits from like argument. Claim 3 therefore complies with 35 U.S.C. §112, first paragraph. Accordingly, withdrawal of the Examiner’s rejection is respectfully requested.

Claim 6: Claim 6 also depends from claim 1, benefiting from like argument. Furthermore, claim 6 is original and therefore supported by the ‘943 Application and in compliance with 35 U.S.C. §112, first paragraph. See also Specification p. 11, ¶[0072]

and FIG. 13B for additional support. Withdrawal of the Examiner's rejection is respectfully requested.

Claim 7: This claim likewise depends from claim 1 and benefits from like argument. Furthermore, claim 7 complies with 35 U.S.C. §112, first paragraph at least because it is original and therefore is supported by the '943 Application as filed. In addition, the '943 specification as filed describes the at least partially reflective symbol. See, e.g., Specification p. 8, lines 9-10 of ¶[0056]. We submit that claim 7 complies with 35 U.S.C. §112, first paragraph. We therefore respectfully request withdrawal of the Examiner's rejection.

Claim 8: Claim 8 also depends from claim 1, benefiting from like argument. Claim 7 is additionally original, therefore the recited limitation of an at least partially reflective front face is supported by the '943 Application as filed. In addition, this limitation is taught and depicted by the original specification and drawings. See, e.g., Specification pp. 7-8, ¶¶[0055]-[0056]; FIG. 4. Claim 8 therefore also complies with 35 U.S.C. §112, first paragraph. Withdrawal of the Examiner's rejection is respectfully requested.

Claim 11: Claim 11 also depends from claim 1 and benefits from like argument. See also FIG. 13D and Specification p. 12, ¶[0078], for exemplary support for the recited at least one railing. Claim 11 thus complies with 35 U.S.C. §112, first paragraph, and we respectfully request withdrawal of the Examiner's rejection.

Claim 28: Claim 28 recites a pavement tape having:

- a continuous elongated flexible unitary tape body of homogenous composition, including:
 - a front face and
 - a continuously flat rear face;
- the rear face configured to be affixed to a durable surface of a road or walkway; and

- the front face bearing at least one symbol that conveys information to persons traveling over the road or walkway, wherein the symbol is printed on the front face.

In rejecting claim 28, the Examiner maintains that the phrase “homogeneous composition” was not supported by the ‘943 Application, as originally filed, because of lack of any definition therefor in the specification.

As noted above with respect to claim 1, “While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, *or inherent* disclosure.” MPEP 2163(I)(B), emphasis added. We argued, and we maintain, that the limitation homogeneous composition is inherently disclosed in the specification, at least because the specification references the drawings, which show a homogenous (for example, consistent or uniform) tape body. See, e.g., Figs. 5-13.

Again, “information contained in any one of the specification, claims *or drawings* of the application as filed *may be added to any other part of the application* without introducing new matter.” MPEP § 2163.06, emphasis added. The amendment to claim 28 constitutes the addition of pictorial information from the drawings into the claim, and is therefore acceptable and in compliance with 35 U.S.C. §112, first paragraph.

Furthermore, we submit that this pictorial information (e.g., of FIGs. 5-13) supports Appellant’s possession of a homogenous tape body. Regarding possession, in describing the guidelines for the examination of patent applications under the 35 U.S.C. § 112, paragraph 1, “Written Description” Requirement, it is clearly stated that:

“An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, *figures, diagrams*, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).” MPEP § 2163(I), emphasis added.

For at least these reasons, we believe that claim 28 complies with the requirements of 35 U.S.C. § 112. Withdrawal of the Examiner’s rejection is therefore respectfully requested.

Claim 29: Claim 29 depends from claim 28, and benefits from like argument. Claim 29 includes the additional limitation of a pavement tape with a rear face having an adhesive for bonding the pavement tape to the durable surface of a road or walkway. This limitation is fully supported by the '943 Application as filed. See, e.g., FIGs. 10, 11, 13B, 17, 21 and 22; Specification p. 11, ¶¶[0071], [0072] and [0074]. We submit that claim 29 complies with 35 U.S.C. §112, first paragraph, and we respectfully request withdrawal of the Examiner's rejection.

Claim 30: Claim 30 depends from claim 28, through intervening claim 29, and benefits from like argument. Claim 30 also recites a flexible release tape, which is fully supported by the '943 Application as filed. See, e.g., FIGs. 12, 13; Specification p. 10, ¶[0068]. We submit that claim 29 complies with 35 U.S.C. §112, first paragraph. Accordingly, withdrawal of the Examiner's rejection is respectfully requested.

Claim 31: Claim 31 also depends from claim 28, thus benefiting from like argument. Claim 31 additionally recites a flexible protective tape, which is fully supported by the '943 Application as filed. See, e.g., FIGs. 9, 10; Specification p. 8, ¶[0059]. Claim 31 is in compliance with 35 U.S.C. §112, first paragraph. We therefore respectfully request withdrawal of the Examiner's rejection.

Claim 32: Claim 32 likewise depends from claim 28 and benefits from like argument. Claim 32 further recites that the at least one symbol conveys commercial information. See Specification p. 8, ¶¶[0072]-[0074] and claim 12 as filed, for exemplary (and original) support for claim 32. We submit that claim 32 complies with 35 U.S.C. §112, first paragraph, and we respectfully request withdrawal of the Examiner's rejection.

Claim 33: Claim 33 likewise depends from claim 28 and benefits from like argument. Claim 33 additionally recites the fully supported limitation of a tape body that is about 6 to about 12 inches in width. See Specification p. 11, ¶[0072]. Claim 33 thus complies with 35 U.S.C. §112, first paragraph. Withdrawal of the Examiner's rejection is respectfully requested.

Claim 34: Finally, claim 34 depends from claim 28, thus benefiting from like argument. Claim 34 also recites the fully supported limitation of one or more of (a) at

least part of the at least one symbol, and (b) the front face being reflective. See Specification p. 8, ¶¶[0056]-[0057]; FIG. 4. Respectfully, we submit that claim 34 complies with 35 U.S.C. §112, first paragraph. Withdrawal of the Examiner's rejection is accordingly requested.

Argument (B).

(1) Arguments Responsive to the Examiner's Answer of August 22, 2007.

Pursuant the Examiner's Answer of August 22, 2007, claims 1-5, 7-8, 11-14, 16-17, 19, 28-32 and 34 stand rejected as being anticipated by Bastiaens. Appellant maintains the arguments presented in the appeal brief of May 2, 2007 (reiterated below). In addition, Appellant notes that claims 12-19 were cancelled in the amendment of July 17, 2007. See Argument (F) for further discussion of entry or non-entry of these amendments.

The Examiner states that "Bastiaens shows a tape body of homogeneous composition because the body (30) is a polymeric material...that has microspheres dispersed uniformly throughout the body", Examiner's Answer, p. 8, second paragraph. Respectfully, we again argue that this is not a homogeneous composition, since some portions of Bastiaens' binder layer (30) have microspheres and some do not. See for example Bastiaens' FIG. 2 and consider a cross section taken through a microsphere of binder layer (30) vs. a cross section taken between microspheres. These cross sections differ in composition. On the other hand, consider the appearance of cross sections taken through Appellant's tape body 101 (see, e.g., tape body 101 of FIGs. 7 and 8). Such cross sections share the same composition, since the composition Appellant's tape body 101 is not interrupted by embedded microspheres. See also reiterated arguments, below.

Pursuant to the rules, Appellant welcomes (or would have welcomed) the Examiner's input, to suggest better wording to describe the appreciable difference between Bastiaens' non-homogeneous binder layer (30) and Appellant's tape body 101.

Regarding claim 4, the Examiner states that "[a]s for the argument that 'there is no mention of adhesive property accorded to Bastiaens transfer sheet', please find that

claim 4 also fails to recite the alleged adhesive property. All claim 4 recites is ‘releasably bonded’ and said phrase is not limited to adhesive only.” Examiner’s Answer p. 9, first paragraph. Respectfully, the Examiner ignores the fact that claim 4 recites a *tape* that is releasably bonded to a front face of Appellant’s pavement tape. As is well known in the art, a tape includes an adhesive. Hence, Appellant’s arguments about the problems that a tape or an adhesive would cause if used with Bastiaens (e.g., with paper support base 3 and image transfer sheet 7) are well founded and should be carefully considered. In brief, we note that:

- Bastiaens clearly states that “the image transfer sheet 7 comprises a *paper* support base 3.” Bastiaens col. 2, line 42-43. Tape is not mentioned, nor is adhesive mentioned. Indeed, the recommended materials for Bastiaens’ transfer sheet do not include adhesive properties.
- Bastiaens specifically teaches that the transfer sheet (7) is used in making the retroreflective article, but it is not a part of the finished product.
- Using a tape or adhesive during image transfer, as the Examiner suggests, would likely cause the transfer medium to stick to itself when wound on a feed roll, as in Bastiaens.

See reiterated arguments, below, for full discussion of the above points.

Regarding claim 7, please see the reiterated arguments, below.

Regarding claim 11, Appellant again notes that contrary to the Examiner’s position, the railing of claim 11 is a part of the tape structure. Claim 11 recites “the pavement tape of claim 1 further comprising at least one railing”. “The transitional term ‘comprising’...is synonymous with ‘including,’ ‘containing,’ or ‘characterized by’. The transitional term ‘comprising’ (and other comparable terms, e.g., ‘containing,’ and ‘including’) is ‘open-ended’- *it covers the expressly recited subject matter*, alone or in combination with unrecited subject matter.” MPEP § 2163(II)(a)(1), emphasis added. In other words, “Comprising” is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct

within the scope of the claim. MPEP § 2111.03, quoting *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948). Hence, "comprising" links the railing to the pavement tape, whether or not the railing is attachable to pavement. See reiterated arguments, below, for further discussion.

(2) Appeal Brief Arguments – Reiterated.

In order to anticipate claims 1-5, 7-8, 11, 28-32 and 34, Bastiaens must teach every element of each claim and "the *identical invention* must be shown in as complete detail as contained in the ... claim." *MPEP 2131*, citing *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989), emphasis added. However, Bastiaens does not teach or suggest each and every claim limitation within claims 1-5, 7-8, 11, 28-32 and 34, as required by 35 U.S.C. § 102(e). These claims do not stand or fall together.

Claim 1: Claim 1 recites a pavement tape for conveying information when affixed to pavement, including:

- a continuous elongated flexible tape body of homogeneous composition, said tape body configured for affixing to pavement and comprising:
 - a front face and
 - a continuously flat rear face,
 - wherein at least one symbol printed upon said front face conveys information, and
 - wherein the front and rear faces are exposed at an end of the continuous elongated flexible tape body.

Bastiaens does not teach or suggest a tape body of homogeneous composition (again, we maintain that this limitation of claim 1 complies with 35 U.S.C. § 112). Bastiaens instead teaches against a homogeneous tape body by specifically reciting a

receptor sheet (which the Examiner has likened to Appellant's tape body 101, 201) that includes a base material of non-homogeneous composition.

For example, "the surface of the base material comprises a binder layer of polyvinyl butyral resin having glass microspheres enclosed therein and a specular reflective layer underlying and spaced apart from the microspheres by the resin." Bastiaens col. 1, lines 51-55, emphasis added; see also FIGs. 2 and 4. This mixed binder layer of the surface is not homogenous, because it is not consistent in composition (e.g., having glass microspheres suspended throughout the binder layer). We maintain that if a part of the base material is not homogeneous (e.g., the mixed binder layer), then the base material as a whole is also not homogeneous.

Again, the base material is a part of the receptor sheet. Note that microspheres 32, binder layer 30 and specular layer 34 are shown and described as components of receptor sheet 18. See Bastiaens' FIGs. 2, 4 and col. 2, line 63 – col. 3, line 6. We maintain, that if a part of Bastiaens' receptor sheet (e.g., the base material) is not homogeneous, then neither is the receptor sheet 18 as a whole. Bastiaens therefore does not teach a tape body of homogeneous composition.

The Examiner stated that this argument was not persuasive, "because, as shown in figure-2 of Bastiaens, the layers 34 or 30 are found to be homogenous." Final office action mailed 5/15/2006, "Response to Arguments," ¶2. We continue to disagree. Layer 30 is not consistent, or homogeneous, in composition. In some places, it includes glass microspheres, and in others, it does not. Bastiaens' receptor sheet 18 fails to anticipate tape body 101, because it is clearly not homogenous. Compare, for example, receptor sheet 18 in Bastiaens FIGs. 2 and 4 with Appellant's tape body 101, in FIGs. 5-13.

The Examiner has also offered the alternate rejection that:

"...the instant claimed invention does not preclude the presence of additional components in the 'homogeneous' tape body. To further explain, applicant is reminded that the recited claims 1 and 28 are directed to open language and, as such, does not preclude the presence of additional components therein. Hence, Bastiaens' body 18 has been interpreted to read on the claimed tape body, while said tape body includes for example a resin layer 30 that is shown to be 'homogeneous.' In

response to applicant's argument about the presence of glass microspheres in the resin layer...the presence of said microspheres is not precluded by the open claim language." Advisory action p. 2, ¶3.

Respectfully, whether or not "comprising" is open-ended, imbuing Appellant's claim 1 with a resin layer and enclosed glass microspheres, as the Examiner does, is antithetical to "homogeneous composition." For example, if one took a tape body of homogeneous composition and placed microspheres therein, we submit that the tape body would no longer be homogeneous. It would instead be heterogeneous, and cross-sections taken along the tape body would differ from one another in composition.

We submit that reading antithetical limitations into the claims, as the Examiner appears to do under the guise of open language, is akin to Appellant adding a new claim to this effect:

"The pavement tape of claim 1, wherein the tape body of homogeneous composition is not homogeneous."

We do not believe that this would be permissible; thus, we submit that it is also not permissible to read in limitations that are opposite the meaning of the claim language. Contrary to the Examiner's position, we believe that open claim language does preclude unrecited elements/components that stand in opposition to the written limitations.

Consideration of this argument is respectfully requested.

If this case is remanded to the Examiner or if the Examiner again re-opens prosecution, we again request that if the Examiner remains unsatisfied with the phrase "homogeneous composition", he propose alternate language to describe the notable difference between Appellant's tape body and Bastiaens receptor sheet 18. This difference is clearly seen in comparing Appellant's FIGs. 5-13 with Bastiaens FIG. 4). Per MPEP 2173.02:

"Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement."
Emphasis added.

We believe that claim 1 is patentable over Bastiaens at least in light of the above argument. We therefore request withdrawal of the Examiner's rejection, and allowance of independent claim 1.

Claim 2: Claim 2 depends from claim 1 and benefits from like argument, namely, that Bastiaens does not teach a tape body of homogeneous composition. In addition, claim 2 adds the limitation of the rear face having adhesive for bonding pavement tape to pavement. Bastiaens does not teach this limitation, in the context of claim 1. We respectfully request withdrawal of the Examiner's rejection.

Claim 3: Claim 3 depends from claim 1 through intervening claim 2, and therefore benefits from like argument. Claim 3 adds the additional limitation of a flexible release tape, one face of which is releasably bonded to said adhesive. Bastiaens does not teach a tape body of homogeneous composition, with said release tape. Accordingly, we respectfully request withdrawal of the Examiner's rejection.

Claim 4: Claim 4 depends from claim 1, and therefore benefits from like argument. In addition, Claim 4 recites a flexible protective tape, one face of which is releasably bonded to the front face of Appellant's pavement tape.

The Examiner has repeatedly argued that Bastiaens teaches this limitation, stating "as clearly seen in figure-21 of Bastiaens, the layer (7) is a tape that protects the image and the top surface until it is removed therefrom." Final office action of 5/15/2006, p. 4, lines 7-8. Respectfully, we strongly disagree and submit that this is incorrect. Bastiaens' transfer sheet 7 is not a tape, and Bastiaens nowhere teaches or suggests that it serves a protective function.

First, there is no mention of any adhesive property accorded to Bastiaens' transfer sheet. For example, Bastiaens clearly states that "the image transfer sheet 7 comprises a paper support base 3." Bastiaens col. 2, line 42-43. Next, as is well known in the art of image transfer, a transfer sheet holds an image which is then transferred to a separate substrate. It is typically utilized only for the purpose of transferring the image, after which it is thrown away or recycled. It does not form a part of the final product.

Accordingly, Bastiaens specifically teaches that the transfer sheet (7) is used in making the retroreflective article, but it is not a part of the finished product:

“The printer 100 uses electrostatic means to form and develop a latent electrostatic image on an image transfer sheet 7 which may be a single sheet or a continuous web. The image transfer sheet 7 comprises a paper support base 3 having first a conductive layer 2 and then a dielectric layer 4. A release coating 6 may be applied to the dielectric layer 4 to facilitate transfer of an image. The surface of the image transfer sheet 7 having the release coating 6 proceeds in a direction 8 first passing a stylus writing head 10 which deposits a charge 12 having varying charge density to define a latent electrostatic image. After passing the writing head 10, the image transfer sheet 7 passes a toning station comprising a toner applicator 16 in contact with a liquid toner bath 18 in a container 20 [sic.]. The liquid toner comprises toner particles dispersed in an insulating liquid and are collectively referred to as the liquid toner bath 18. Liquid toner 22 is transported by the applicator 16 to the image transfer sheet 7 and deposited to form a toned image 24 conforming to the latent electrostatic image 12.” Bastiaens col. 2, lines 38-57; FIG. 1. Furthermore, “The image transfer sheet web 28 and the receptor sheet web 38 pass through the nip 40 of rollers 42, 44 where heat and pressure are applied *to transfer the toned image 24 from the image transfer sheet web 28 to the surface 33 of binder layer 30 of the receptor sheet web 38. The continuous webs 28, 38 are collected by pickup rolls 36, 34. The imaged receptor sheet provides a base construction suitable for making retroreflective articles.*” Bastiaens col. 3, lines 15-22, emphasis added.

Bastiaens’ FIG. 3 illustrates image transfer sheet web 28 being collected on a pickup roll after transfer of the toned image. As is clearly shown and described, the imaged receptor sheet web 34 is collected on a different pickup roll. The product on the receptor sheet web 34 (which again does not include the transfer sheet) is then suitable for making retroreflective articles. The transfer sheet is plainly not a part of the base construction that is used to make Bastiaens’ retroreflective articles.

Respectfully, the Examiner’s ruling indicates a misunderstanding of the process of image transfer. In image transfer of the type practiced in Bastiaens, the transfer sheet typically does not include any adhesive. Indeed, Bastiaens lists Trident Transfer Paper

ES as a suitable transfer sheet. In our Response of February 24, 2006, we provided the Examiner with the Product Bulletin for Trident Transfer Paper ES. This bulletin does not mention any adhesive properties. This is not surprising, because common sense teaches against using a tape or even an adhesive paper as the transfer sheet in Bastiaens.

For example, if Bastiaens were to use a sticky transfer sheet or a tape, the transfer paper would likely stick to itself when wound on feed roll 20. This would make it difficult to cleanly pass the transfer sheet web through Bastiaens' image transfer station 300. Furthermore, if transfer sheet 7 included an adhesive, it might melt when passed "through the nip 40 of rollers 42, 44 where heat and pressure are applied." Bastiaens col. 3, lines 15-16. This would likely leave a residue not only on roller 42, potentially gumming up the image transfer station. In addition, the transfer sheet would stick to the receptor sheet. When pulled apart, the receptor sheet could easily be damaged. At the very least, a residue would likely be left on the receptor sheet, causing the receptor sheet to stick to itself when wound on pickup roll 34. This could cause damage to the finished receptor sheet, for example when a person or machine attempts to un-wind it from pickup roll 34. See Bastiaens' FIG. 3.

Bastiaens recites that the transfer sheet feed roll 20 can be positioned before or after a printer. In addition to the above drawbacks, if Bastiaens used a sticky transfer paper or tape, the following scenarios could result:

(i) With roll 20 positioned before printer 100:

In this case, as noted above, the transfer sheet web would likely stick to itself on roll 20, leaving a residue upon the transfer sheet when unwound for printing. Therefore, images would not be applied to a clean receptor sheet at printer 100, but to a sheet bearing an adhesive residue. This would likely degrade image quality and stability on the receptor sheet. See Bastiaens FIG. 3.

(ii) With roll 20 positioned after printer 100:

In this case (although Bastiaens teaches nothing of the sort) images would presumably be printed on an adhesive-free side of the transfer sheet, prior to winding

upon roll 20. However, winding the imaged sheet upon roll 20 would cause the adhesive side of the transfer sheet to contact the imaged side. As noted above, the wound transfer sheet would likely stick to itself, causing difficulty in feeding the sheet through the image transfer station. In addition, part or all of the images could be pulled from the imaged side of the transfer sheet to the adhesive side, during unwinding. This would result in a lesser quality image, or no image at all, being transferred to the receptor sheet at pressure rolls 42, 44. See Bastiaens FIG. 3.

As shown, not only is Bastiaens completely silent as to any adhesive on transfer sheet 7, logic also teaches against such an adhesive. Furthermore, claim 4 recites a protective tape. Bastiaens nowhere describes transfer sheet 7 as having a protective function.

Respectfully, Bastiaens' transfer sheet does not provide sufficient basis for an anticipation rejection. Transfer sheet 7 is not a tape, it is not bonded to Bastiaens' base construction, and Bastiaens nowhere indicates that it has any protective function.

Since Bastiaens fails to expressly teach the limitations of claim 4, it appears that the Examiner is rejecting claim 4 based upon an inherency argument (per MPEP § 2131, a claim is only anticipated if every element is found, either expressly or inherently). We must therefore point out the inappropriateness of the Examiner's repeated comment that "Applicant has failed to show" that transfer sheet (7) does not provide protection to Bastiaens' tape. See advisory action p. 2, ¶6 and final office action of 5/16/06, p. 4, lines 9-10.

In cases of inherency, the burden of proof lies not with Applicant, but with the Examiner. MPEP § 2112 states:

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2D 1461, 1464 (Bd. Pat. App. & Inter. 1990)."

Although we have pointed out this responsibility, the Examiner has yet to provide any basis in fact or technical reasoning to support the allegation that transfer sheet 7 is a tape,

or that transfer sheet 7 has a protective function. We contend that such factual support or technical reasoning cannot be found, especially in light of Bastiaens' specific teaching that transfer sheet 7 is used to transfer an image to a receptor sheet. In addition, as noted, logic teaches away from transfer sheet 7 having adhesive properties at all. The Examiner's rejection of claim 4 therefore fails, and we respectfully request withdrawal of this rejection.

Claim 5: Claim 5 likewise depends from claim 1, and benefits from like argument, namely, that Bastiaens does not teach a tape body of homogeneous composition. In addition, claim 5 adds the limitation of the at least one symbol conveying commercial information. Bastiaens does not teach this limitation of claim 5, in the context of claim 1.

Claim 7: Claim 7 also depends from claim 1 and benefits from like argument, namely, that Bastiaens does not teach a tape body of homogeneous composition. In addition, claim 2 recites an at least partially reflective symbol. We presented arguments demonstrating that Bastiaens does not teach this limitation. The Examiner felt that our arguments did not make sense (see final office action of 5/16/06), and we provided clarifying remarks in our Response of July 17, 2006. Because these remarks were not addressed in the advisory action of 8/2/2006, they are reiterated herein. We respectfully request consideration of the following:

Bastiaens recites a retroreflective article with an image on a base material, wherein "the surface of the base material comprises a binder layer of polyvinyl butyral resin having glass microspheres enclosed therein and a specular reflective layer underlying and spaced apart from the microspheres by the resin." col. 1, lines 53-55; see also FIG. 2 and col. 2, line 63 - col. 3, line 4. "The receptor sheet is a base material comprising glass microspheres that provide a low level of retroreflectivity. The glass microspheres are dispersed throughout the binder layer and are present substantially as a monolayer dispersed in the binder layer with an underlying specular reflective layer spaced from the microspheres by the transparent binder material." Bastiaens col. 4, lines 4-10. An image is transferred to this base material, in particular, "to the side of the base

material closest to the microspheres and opposite the reflective layer.” Bastiaens col. 4, lines 34-35. In other words, the base material (e.g., the specular reflective layer and the glass microspheres), and not the symbol itself, appear to be reflective in Bastiaens.

On the other hand, claim 7 recites that at least part of the symbol itself is reflective. Again, absent an express teaching of a reflective (or partially reflective) symbol by Bastiaens, the Examiner appears to be making an inherency argument. However, the Examiner has not provided any basis in fact, or any technical reasoning, to support the opinion that Bastiaens’ image is at least partially reflective (though we have pointed out that this is the Examiner’s responsibility). Since Bastiaens does not teach a reflective symbol, we believe that such basis cannot be found. We believe that the rejection of claim 7 therefore fails. Accordingly, withdrawal of the rejection is respectfully requested.

Claim 8: Claim 8 also depends from claim 1, and benefits from like argument. Furthermore, claim 8 recites that at least part of the tape body front face is reflective. The limitations of claim 8 are simply not taught in the context of claim 1. For example, Bastiaens fails to teach a pavement tape with a tape body of homogeneous composition and an at least partially reflective front face. Withdrawal of the rejection is accordingly requested.

Claim 11: Claim 11 also depends from claim 1 and benefits from like argument. Claim 11 also recites the unique limitation of at least one railing attachable to the pavement and configured for protecting at least one edge of said pavement tape.

The Examiner stated that the claim 11 railing was not given patentable weight because it was “not found to be of positive limitation, as it is attached to the intended use pavement and not part of the claimed tape.” Office action of 10/24/2005, p. 5, ¶3. We presented arguments that the railing is a part of the tape, which the Examiner did not accept. See final office action of 5/16/2006 p. 4, ¶4. We have since clarified our position; however, the Examiner has not addressed our argument.

As previously argued, claim 11 recites “The pavement tape of claim 1 further comprising at least one railing”. As noted in MPEP § 2111.03, “The transitional term

‘comprising’...is synonymous with ‘including,’ ‘containing,’ or ‘characterized by’. The transitional term ‘comprising’ (and other comparable terms, e.g., ‘containing,’ and ‘including’) is ‘open-ended’- *it covers the expressly recited subject matter*, alone or in combination with unrecited subject matter.” MPEP § 2163(II)(a)(1), emphasis added. In other words, “Comprising” is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim. MPEP § 2111.03, quoting *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948).

As supported by the above teachings, claim 11 covers a pavement tape including the expressly recited at least one protective railing. We therefore contend that this railing does indeed have patentable weight. Bastiaens is completely silent as to any railing; therefore claim 11 is not anticipated. Withdrawal of the Examiner’s rejection under 35 U.S.C. § 102(e) is respectfully requested.

The Examiner recently commented that our claim 11 argument was an admission that “comprising” is open language, and attempted to use this argument as support for his rejection of the “homogeneous composition” limitation of claims 1 and 28. We therefore submit once more that whether or not “comprising” is open language, it is not appropriate (and we believe it is also impermissible) to read in limitations that contradict expressly written limitations (e.g., reading glass microspheres into Appellant’s homogeneous tape body). The MPEP quotations presented above do not indicate or even suggest that open claim language covers unrecited subject matter that would change the meaning of the claim (e.g., contradicting expressly recited limitations)

Claim 28: Turning now to claim 28, what is described is a pavement tape having:

- a continuous elongated flexible unitary tape body of homogenous composition, including:
 - a front face and

- a continuously flat rear face;
- the rear face configured to be affixed to a durable surface of a road or walkway; and
- the front face bearing at least one symbol that conveys information to persons traveling over the road or walkway, wherein the symbol is printed on the front face.

As noted above with respect to claim 1, Bastiaens does not teach or suggest a tape body of homogeneous composition (and we maintain that this limitation of claim 28 complies with 35 U.S.C. § 112). Bastiaens instead teaches against a homogeneous tape body by specifically reciting a heterogeneous receptor sheet 18 (which the Examiner has likened to Appellant's tape body 101, 201).

For example, the receptor sheet includes a base material and "the surface of the base material comprises a binder layer of polyvinyl butyral resin having glass microspheres enclosed therein and a specular reflective layer underlying and spaced apart from the microspheres by the resin." Bastiaens col. 1, lines 51-55, emphasis added; see also FIGs. 2 and 4. This mixed binder layer is not homogenous, because it is not consistent in composition (e.g., having glass microspheres in some places, but not in others). If this element of the base material is not homogeneous (e.g., the mixed binder layer), then we submit that the base material as a whole is also not homogeneous.

Again, the base material is a part of the receptor sheet. Note that microspheres 32, binder layer 30 and specular layer 34 are shown and described as components of receptor sheet 18. See Bastiaens' FIGs. 2, 4 and col. 2, line 63 – col. 3, line 6. If a part of Bastiaens' receptor sheet (e.g., the base material) is not homogeneous, then we submit that neither is the receptor sheet as a whole. Bastiaens does not teach a tape body of homogeneous composition, and is therefore different from (and does not anticipate) claim 28. Compare, for example, receptor sheet 18 in Bastiaens FIGs. 2 and 4 with Appellant's tape body 101, in FIGs. 5-13. .

We again strongly disagree with the Examiner's alternate rejection, on the grounds that the open language of claim 28 does not preclude the presence of glass

microspheres. See Advisory Section p. 2, second paragraph. We maintain that open claim language does preclude the presence of components/limitations which would change the meaning of the claim, for example by canceling out, or contradicting, expressly written limitations. For this reason, we submit that it is improper to read glass microspheres into Appellant's tape body of homogeneous composition, as doing so would result in a tape body of inconsistent (i.e., heterogeneous) composition.

Consideration of this point is respectfully requested.

We believe that claim 1 is patentable over Bastiaens at least in light of the above argument. However, Bastiaens also fails to teach other limitations of claim 1. For example, Bastiaens does not teach or suggest a pavement tape with a symbol printed upon its front face. Withdrawal of the Examiner's rejection is therefore respectfully requested.

Claim 29: Claim 29 depends from claim 28, and benefits from like argument. Claim 29 includes the additional limitation of a pavement tape with a rear face having an adhesive for bonding the pavement tape to the durable surface of a road or walkway. Bastiaens does not teach the limitations of claim 29, in the context of claim 28. For example, Bastiaens does not teach a pavement tape having a tape body of homogeneous composition, and the recited adhesive on its rear face. We thus respectfully request withdrawal of the claim 29 rejection.

Claim 30: Claim also 30 depends from claim 28, through intervening claim 29, and benefits from like argument. Claim 30 also recites a flexible release tape. Bastiaens does not teach the flexible release tape of claim 30, in the context of a pavement tape having a homogeneous tape body. Withdrawal of the Examiner's rejection is respectfully requested.

Claim 31: Claim 31 also depends from claim 28, thus benefiting from like argument. Claim 31 additionally recites a flexible protective tape. Bastiaens does not teach this limitation, in the context of claim 28. Withdrawal of the rejection under 35 U.S.C. § 102(e) is thus respectfully requested.

Claim 32: Claim 32 likewise depends from claim 28 and benefits from like argument. Claim 32 further recites that the at least one symbol conveys commercial information. Again, Bastiaens does not teach this limitation of claim 32, in the context of claim 28. Withdrawal of the rejection is therefore respectfully requested.

Claim 34: Finally, claim 34 depends from claim 28, thus benefiting from like argument. Claim 34 also recites one or more of (a) at least part of the at least one symbol, and (b) the front face being reflective.

Bastiaens fails to teach at least element (a), above. As noted with respect to the arguments supporting claim 7, Bastiaens does not teach a reflective symbol, but rather teaches a reflective base material. Bastiaens specifies that “the surface of the base material comprises a binder layer of polyvinyl butyral resin having glass microspheres enclosed therein and a specular reflective layer underlying and spaced apart from the microspheres by the resin.” col. 1, lines 53-55; see also FIG. 2 and col. 2, line 63 - col. 3, line 4. “The receptor sheet is a base material comprising glass microspheres that provide a low level of retroreflectivity...with an underlying specular reflective layer spaced from the microspheres by the transparent binder material.” Bastiaens col. 4, lines 4-10.

The image upon Bastiaens’ base material is not described or depicted as reflective, in whole or in part. Absent an express teaching of a reflective (or partially reflective) symbol by Bastiaens, the Examiner appears to again make an inherency argument. We have pointed out that it is the Examiner’s responsibility to provide a basis in fact, or any technical reasoning to support the opinion that Bastiaens’ image is at least partially reflective. However, we have yet to receive any such fact or reasoning. Since Bastiaens does not teach a reflective symbol, we believe that such basis cannot be found.

On the other hand, claim 34 recites that at least part of the symbol itself is reflective. We believe that the rejection of claim 7 therefore fails. In addition, Bastiaens does not teach claim 34 limitation (a) or claim 34 limitation (b), in the context of base claim 28. In other words, Bastiaens at least fails to teach a tape body of homogeneous composition with (a) at least part of a symbol, or (b) the front face, being reflective. Accordingly, withdrawal of the rejection is respectfully requested.

Argument (C).

(1) Arguments Responsive to the Examiner's Answer of August 22, 2007

The Examiner does not specifically respond to Appellant's arguments against the § 103 rejection of claims 6 and 33; hence, no specific reply is given herein. However, Appellant does note that the Examiner's Answer recognizes that claim 15 was mistakenly listed with claims 6 and 33. This adds to the confusion regarding the amendment of July 17, 2006, which cancelled claims 12-19 and 35. Were these claims cancelled, or were they not? The Examiner's note suggests that claim 15 was cancelled; however, claims 12-14, 16-17 and 19 have appeared in the § 102 rejections based upon Bastiaens, and the Examiner has stated that the July 17, 2007 amendment was not entered. Appellant respectfully requests clarification as to the status of these claims. Please see Argument (F), below.

(2) Appeal Brief Arguments - Reiterated

Given the July 17, 2006 cancellation of claim 15 (still not acknowledged within the actual rejections of December 4, 2006), claims 6 and 33 stand rejected as being unpatentable in view of Bastiaens, the Examiner stating that it would have been obvious to provide a pavement tape having the width dimensions recited therein. We again respectfully disagree. These claims do not stand or fall together.

Claim 6: Regardless of whether or not the recited width (6-12 inches) of Appellant's pavement tape would have been obvious, claim 6 depends from claim 1. Bastiaens does not render base claim 1 *prima facie* obvious. For example, Bastiaens does not teach or suggest a pavement tape with a tape body of homogeneous composition. Rather, Bastiaens teaches against such a limitation by showing and describing a heterogeneous receptor sheet 18. Bastiaens also teaches away from a homogeneous receptor sheet by specifying that the embedded glass microspheres impart retroreflectivity to the retroreflective graphic article (which is the subject of Bastiaens). See Bastiaens FIG. 4; col. 4, lines 4-14. Thus, it appears that a heterogeneous receptor sheet (e.g., a binder layer with microspheres dispersed throughout) is essential to Bastiaens.

There is therefore neither suggestion nor motivation to replace Bastiaens' heterogeneous receptor sheet with a homogeneous tape body. Absent such suggestion or motivation, Bastiaens cannot establish *prima facie* obviousness over claim 1.

Claim 6 depends from claim 1, and inherits the claim 1 limitations. Courts have ruled that if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071.5 USPQ2d 1596 (Fed. Cir. 1988). Thus, claim 6 is allowable over Bastiaens, at least because it depends from claim 1. Withdrawal of the Examiner's rejection is respectfully requested.

Claim 33: Claim 33 depends from claim 28, and further recites a tape having a width of 6-12 inches. Again, whether or not such dimensions would have been obvious, Bastiaens does not teach or suggest a homogeneous tape body. Rather, Bastiaens recites and depicts a heterogeneous tape body, which seems integral to Bastiaens' retroreflective graphic articles. For example, the glass microspheres that Bastiaens disperses through the binder layer of her receptor sheet are recited as lending a level of retroreflectivity to the graphic article. See Bastiaens FIG. 4; col. 4, lines 4-14.

Bastiaens fails to teach or suggest each and every limitation of base claim 28. There is also no suggestion or motivation within Bastiaens to replace the heterogeneous receptor sheet with a homogeneous tape body, as is recited in base claim 28. Thus, Bastiaens does not meet the necessary criteria for establishing *prima facie* obviousness under 35 U.S.C. §103. See also MPEP § 2142.

Since base claim 28 is nonobvious, dependent claim 33 (which inherits the claim 28 limitations,) is also nonobvious. Courts have ruled that if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071.5 USPQ2d 1596 (Fed. Cir. 1988). Thus, claim 33 is allowable over Bastiaens. Withdrawal of the Examiner's rejection is respectfully requested.

Argument (D).

(1) Arguments Responsive to the Examiner's Answer of August 22, 2007

Regarding the Examiner's comment that Cabrera's perforation conveys information because it conveys where to place legends on a tape body, Appellant again notes that this is not the same as conveying information as recited in the '943 Application.

(2) Appeal Brief Arguments - Reiterated

Claim 9 stands rejected as being anticipated by U.S. Patent No. 6,576,074 (hereinafter, "Cabrera"). In particular, the Examiner states that Cabrera relates to a pavement tape (relying upon Cabrera Abstract and FIG. 1). The Examiner also states that Cabrera teaches at least one symbol formed as a perforation (relying, it appears, upon Cabrera's legend layer 10 plus orifice 14). We respectfully disagree and traverse the rejection.

Cabrera's legend layer 10 plus orifice 14 is not the same as Appellant's "at least one symbol formed as a perforation". Note that Cabrera's legend layer 10 is component of the disclosed marking system that is separate and apart from orifice 14. A legend layer that is a "precut piece of preformed thermoplastic material," plus an orifice (in a separate background layer) that receives the legend layer is different from a symbol formed as a perforation. See Cabrera col. 3, lines 4-28. For example, the '943 Application recites symbols that are "etched or embossed into the surface of tape body 101...engraved into the surface of tape body 101 [or] cut entirely through tape body 101" [0054].

On the other hand, Cabrera teaches a preferably black background layer, the color chosen for blending with coated asphalt and black asphalt treatment. The background layer has holes cut into it, for receiving legend layer pieces that for example form the word "Thank You." Again, Cabrera specifies that "each letter of the legend layer is a precut piece of preformed thermoplastic material in one or more colors that contrasts with the color of background layer 12." Cabrera col. 3, lines 4-7. Cabrera's background layer then has a plurality of orifices 14 that receive the legend layer (again, note that the legend layer and orifices are different parts of Cabrera's marking system). "For installation, background layer 12 is placed on the pavement surface where installation is desired, and is affixed thereto such as with an adhesive or by fusing with a heat gun or flame torch.

The pre-cut letters of legend layer 10 are then placed in an in-laid manner within the pre-cut orifices 14 of background layer 12, and affixed to the pavement surface by any of the same techniques,” Cabrera col. 3, lines 21-27. Cabrera’s two separate components – an orifice plus a pre-cut piece of thermoplastic material of complementary shape – are not the same as Appellant’s symbol formed as a perforation at least partly through a tape body.

If we have misinterpreted the Examiner’s comments and the Examiner meant instead to liken only Cabrera’s orifice 14 to Appellant’s symbol formed as a perforation, we must point out that the likelihood of orifice 14 ‘conveying information’ is slim to none. It is highly unlikely that an orifice in a black background layer, through which black-treated asphalt is visible, would successfully convey any information. One would have to be very close indeed to make out any information cut into a black-on-black marking system. And this would counter Cabrera’s goal of providing “enhanced visual contrast” and “greater conspicuity of the message”, Cabrera col. 4, lines 20-21. Of further note, Cabrera goes on to specify that the message is “conveyed by the legend layer 10.” Cabrera col. 4, line 21. And again, legend layer 10 is not a symbol formed as a perforation, as in claim 9, but instead is made of pre-cut pieces of thermoplastic material (see Cabrera col. 3, lines 4-7, quoted above).

Furthermore, Cabrera nowhere says that background layer 12 or legend layer 10 are tapes. Instead, as noted above, Cabrera indicates that these layers can be applied by fusing with a heat gun or by using an adhesive. Using an adhesive is not the same as a tape. For example, applying glue to a piece of paper and then gluing the paper to an item is different from applying a piece of tape to the item. And Cabrera nowhere teaches or suggests that his background or legend layers are tapes. Absent such teaching or suggestion, Cabrera therefore fails to teach or suggest at least two elements of claim 9.

We also note that Cabrera does not recite the word “tape” in connection with his invention, except to state that HOTape® (an Avery Dennison product) can be used as the background or legend layer. See Cabrera col. 4, lines 26-31. However, HOTape is

widely recognized as a thermoplastic material, which must be heated in place. This is different from Appellant's tape, which is for example applied as follows:

"The composite tape structure of FIG. 10 was positioned over pavement 110 and the exact placement of the tape structure was determined and achieved. The FIG. 10 tape structure was then lowered to pavement 110 so that pavement tape adhesive 112 contacted pavement 110. **Pressure was then applied to protective tape 108 until the bond between the FIG. 10 composite tape structure and pavement 110 met the specifications dictated by the application.** The amount and duration of pressure on the FIG. 10 tape structure are functions, among other things, of the type of adhesive used, the composition of tape body 101, the composition and surface condition of pavement 110, and the ambient conditions at the time of application." [0069], FIGs. 10 and 11.

Cabrera does not teach, depict or even suggest all of the elements of claim 9. The Examiner's 102 rejection accordingly fails, and we respectfully request withdrawal of the rejection and allowance of claim 9.

Argument (E).

(1) Arguments Responsive to the Examiner's Answer of August 22, 2007

The Examiner expresses confusion as to why Appellant refers to Jacobs element "(22) as the tape body, when in the rejection over Jacobs, it has been clearly mentioned that the tape body is (30)." Examiner's Answer, p. 10, fourth paragraph. Respectfully, Appellant referred to Jacobs element (22) because the Examiner construed a "depression" in Jacobs and stated that this depression was interpreted to convey information such as indicating the location for an adhesive pattern. However, the Examiner did not indicate what structure in Jacobs represented this depression. This left Appellant to guess at the Examiner's thinking; hence, Appellant guessed that the Examiner might be discussing the area of element (22) between raised magnetic paving elements 24.

Confusion over the Examiner's rejection remains. The Examiner states that "the depression is the portion of the tape body (30) containing the adhesive (26) therein", and that "said depression conveys the information as to where the adhesive is located because the adhesive is provided in a pattern." Examiner's Answer p. 10, final paragraph.

Appellant notes that this depression is an invention of the Examiner, since Jacobs does

not recite depression at all. Appellant further notes that the Examiner argues that these depressions convey information "because the adhesive is provided in a pattern." Hence, if the adhesive is not applied in a pattern, the Examiner's argument falls apart.

In order to anticipate claim 10, Jacobs must recite a tape body with a front face comprising at least one symbol that conveys information. However, Jacobs clearly teaches that the adhesive is only applied in an pattern (which is required to sustain the Examiner's argument regarding conveyance of information) when it is applied to the bottom of magnetic paving elements. Otherwise, it is applied not in a pattern but across the entire surface of a carrier web 22 and the paving elements:

"An adhesive 26 is pattern coated *to a bottom surface 28 of the magnetic pavement elements 24*. The adhesive 26 may alternatively be coated *across the entire surface of the carrier web 22* and the magnetic pavement elements 24 without being applied to the interstitial portions of web 22." Jacobs p. 4, ¶[0044], emphasis added, see also figure 1.

Jacobs nowhere recites adhesive or depressions being on a top surface of structure (30), which the Examiner insists is equivalent to the tape body of claim 10. See Examiner's Answer p. 10, final paragraph. Hence, at least one feature of claim 10 is not taught by Jacobs. See reiterated arguments, below, for further discussion.

Claim 10 additionally recites a mask tape with at least one symbol formed as a perforation extending from a front mask face to a rear mask face, said rear mask face of said mask tape being bonded to said front face of said pavement tape. The Examiner states that Jacobs' array of magnetic elements 20 is actually a mask tape that has a symbol formed as a perforation therein. The Examiner further contends that this so-called mask tape is bonded to a pavement tape 30. However, Jacobs nowhere teaches or suggests that this is so. First, Jacobs' item 30 is not a pavement tape, but "A release liner 30 [that] optionally extends across the adhesive 26 until the array 20 is ready for use...The release liner 30 is removed and the array 20 is tamped to the pavement surface 42." Jacobs p. 4, ¶¶[0045]-[0046]. This is clearly different from a pavement tape.

Second, Jacobs' item 32 is not, as the Examiner contends, a **symbol** formed as a perforation. It is a frangible connection where carrier web 22 may be torn away from the magnetic elements that are left behind on the pavement:

“The carrier web 22 that surrounds the magnetic pavement elements 24 is then removed or peeled-back from the array 20 by breaking the frangible connection 32. The resulting array of discrete, magnetic pavement elements 24 is arranged on the pavement surface 42 in substantially the same configuration maintained by the carrier web 22 in the array 20. The discrete pavement elements 24 are not interconnected by the web 22, so that the delamination of a single pavement element does not typically adversely affect adjacent pavement elements.” Jacobs p. 4, ¶[0047].

And Jacobs nowhere teaches any other symbol formed as a perforation, especially not from a top surface to a bottom surface of a mask tape that is then bonded on top of a pavement tape. As argued above, Jacobs' array 20 is not applied on top of any pavement tape. Hence, it is not the same as Appellant's mask tape that is bonded to a front face of a pavement tape. See claim 10. Jacobs thus fails to teach (or even suggest) at least two features of claim 10. See reiterated arguments below, for further discussion.

(2) Appeal Brief Arguments - Reiterated

Claim 10 stands rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. US 2003/0123930A1 (hereinafter, “Jacobs”). Again, we respectfully disagree. Jacobs relates to a magnetic pavement marker, where magnetic elements are arranged in a carrier web that holds the magnetic elements in place until they are fixed onto pavement. The carrier web is then removed or deteriorates, leaving the magnetic elements on the pavement, in the predetermined arrangement. This is different from the pavement tape of claim 10.

Claim 10 recites a pavement tape having an elongated flexible tape body with a front face comprising *at least one symbol that conveys information*. A mask tape has a symbol formed as a perforation extending from the front mask face to the rear mask face. The mask tape is bonded to the front face of the pavement tape.

Contrary to the Examiner's statement, Jacobs simply does not teach these claim elements. For example, the Examiner points to Jacobs figure 1 and states that "the depression on the front face...is interpreted to convey information such as indicating the location for the adhesive pattern", Office Action p. 6, final paragraph. The Examiner does not specifically point out what is considered to be the "depression" of figure 1, however, we assume it is the area between magnetic elements 24. This area is identified in Jacobs as carrier web 22. And carrier web 22 is intended to hold the magnetic elements in a predetermined configuration until they are fixed to the pavement, after which "the portion of the carrier web surrounding the magnetic pavement elements is removed, leaving an array of discrete, magnetic pavement elements." Jacobs col. 2, lines 4-6. Respectfully, we wonder how the Examiner considers this a symbol – we contend that it is not.

The Examiner further states that this "depression" is interpreted to indicate information such as "the location for the adhesive pattern". Office Action p. 6, final paragraph. Respectfully, we do not understand what the Examiner is talking about. The only thing remotely like an adhesive pattern mentioned in Jacobs is an adhesive 26 that is "pattern coated to a bottom surface 28 of the magnetic pavement elements 24." Jacobs p. 4, ¶[0044]. However, this adhesive pattern is not coated to or beneath the Examiner's depression:

"An adhesive 26 is pattern coated to *a bottom surface 28 of the magnetic pavement elements 24*. The adhesive 26 may alternatively be coated across the entire surface of the carrier web 22 and the magnetic pavement elements 24 *without being applied to the interstitial portions of web 22*." Jacobs p. 4, ¶[0044], emphasis added, see also figure 1.

Given (a) that Jacobs does not teach, or even suggest, that these depressions are symbols, (b) that Jacobs nowhere indicates that these depressions convey any type of information, and (c) that these depressions clearly do not indicate what the Examiner argues (i.e., where adhesive is to be coated), the above rejection appears to be pure and somewhat careless hindsight construction by the Examiner. Indeed, the rejections are far enough from what Jacobs actually teaches that we wonder whether the Examiner has actually read the reference. The rejections suggest that the Examiner has simply looked at Jacobs

figure 1 and “created” the claim 10 elements therein, without concern for what is actually depicted and described. We submit that this is impermissible, and that Jacobs must be considered based upon what it actually recites and shows.

The remainder of the Examiner’s statement does nothing to assuage our concerns as to the propriety of this rejection. In addition to blindly creating (in Jacob) an information-conveying symbol that Jacobs clearly does not teach or suggest, the Examiner states that Jacobs’ array of magnetic elements 20 is actually a mask tape that has a symbol formed as a perforation therein. The Examiner further contends that this so-called mask tape is bonded to a pavement tape 30. Respectfully, this is simply wrong. First, Jacobs item 30 is not a pavement tape, but “A release liner 30 [that] optionally extends across the adhesive 26 until the array 20 is ready for use...The release liner 30 is removed and the array 20 is tamped to the pavement surface 42.” Jacobs p. 4, ¶[0045]-[0046]. This is clearly different from a pavement tape.

Second, Jacobs’ item 32 is not, as the Examiner contends, a **symbol** formed as a perforation. It is a frangible connection where carrier web 22 may be torn away from the magnetic elements that are left behind on the pavement:

“The carrier web 22 that surrounds the magnetic pavement elements 24 is then removed or peeled-back from the array 20 by breaking the frangible connection 32. The resulting array of discrete, magnetic pavement elements 24 is arranged on the pavement surface 42 in substantially the same configuration maintained by the carrier web 22 in the array 20. The discrete pavement elements 24 are not interconnected by the web 22, so that the delamination of a single pavement element does not typically adversely affect adjacent pavement elements.” Jacobs p. 4, ¶[0047].

And Jacobs nowhere teaches any other symbol formed as a perforation, especially not from a top surface to a bottom surface of a mask tape that is then bonded on top of a pavement tape. As argued above, Jacobs’ array 20 is not applied on top of any pavement tape. See also Jacobs FIG. 1 showing that there is nothing, not even adhesive, beneath the area that the Examiner likens to Appellant’s symbol that conveys information. See also Jacobs p. 4, ¶[0047], above.

Jacobs very clearly fails to teach or suggest all of the elements of claim 10; therefore, Jacobs can not and does not anticipate claim 10. Accordingly, we respectfully request withdrawal of the Examiner's rejection, and allowance of claim 10.

Argument (F).

On July 17, 2006, Appellant filed an amendment and response canceling claims 12-19 and 35, and including the following amendment to the specification:

“FIG. 1 depicts a top view of a section of a continuous pavement tape 100. This tape comprises a homogeneous tape body 101 and a series of symbols 102 arrayed on the surface of the tape body. Here the symbols 102 define the first three letters of the English alphabet.” *Amendment and Response filed July 17, 2006.*

This amendment was denied entry because the Examiner argued that the application as filed did not provide sufficient support for a homogeneous tape body. The Examiner also objected to an amendment adding the term “homogeneous composition” to claims 1 and 28. However, the Examiner has now seemingly reversed his position, stating that “[t]he phrase ‘homogeneous composition’ in claim 1 and 28 is not supported by the specification, as originally filed, *because figures 5-13 merely describes the homogeneous structure* and contains no description as to the identity or nature of the composition.” Examiner's Answer p. 4, first paragraph, emphasis added. The Examiner admits, and we agree, that figures 5-13 show homogeneity of Appellant's tape body.

Given this admission, support for the term "homogeneous" is no longer contested; rather, the Examiner appears concerned with the precision with which the term is applied. “If the language used by applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph, but the examiner merely wants the applicant to improve the clarity or precision of the language used, *the claim must not be rejected under 35 U.S.C. 112, second paragraph, rather, the examiner should suggest improved language to the applicant.*” MPEP § 2173.02, emphasis added. See Argument (A)(1) for further discussion.

In addition, it is not clear whether claims 12-19 and 35 have been cancelled or not. Appellant has received contradictory information regarding the status of these claims since they were cancelled in the July 17 amendment. In brief:

- Appellant first received a responsive Office Action (December 4, 2006) that did not list claims 12-19 and 35 among the pending claims.
- The December 4 Office Action also failed to specifically address or list any of these claims, except that claim 15 was included in a rejection of claims 6 and 33.
- The recent Examiner's Answer apologizes for previously discussing cancelled claim 15 with claims 6 and 33.
- The Examiner's Answer does not elsewhere discuss cancelled claim 15, and nowhere discusses cancelled claim 35.
- Yet, the Examiner's answer states that the amendments of July 17 were not entered, and claims 13, 14, 16, 17 and 19 are now (newly) listed in the § 102(e) rejection based upon Bastiaens.

Appellant submits that a new, non-final Office Action is the correct vehicle for clarifying the status of claims 12-19 and 35 and for resolving the clarity issues which have replaced the § 112 rejections to the term "homogeneous." Hence, Appellant respectfully requests that this case be remanded to the Examiner for preparation of a new, non-final Office Action, so that these issues may be resolved.

CONCLUSION

Appellant respectfully submits that the claims 1-11 and 28-34 comply with 37 C.F.R. §112 and/or patentably distinguish over the art of record. Appellant further contends that a new, non-final Office Action is in order, given confusion over the status of claims 12-19 and 35 and given the Examiner's admission that figures 5-13 support homogeneity in some form.

This reply brief is timely filed today within two months of the mailing date of the Examiner's Answer. No fees are believed due with this reply brief. However, should any fee be required in connection with the appeal proceedings in the '943 Application, the Commissioner is hereby authorized to charge such fees to Deposit Account 12-0600.

Respectfully submitted,
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